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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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Lawrence P. Bush

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EXAMINER

GOTTSCHALK, MARTIN A

ART UNIT

PAPER NUMBER

3626

DATE MAILED: 03/02/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

**Application No.**

09/930,418

**Applicant(s)**

BUSH, LAWRENCE P.

**Examiner**

Martin A. Gottschalk

**Art Unit**

3626

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 15 August 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-27 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-27 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 15 August 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

### DETAILED ACTION

1. Claims 1-27 have been examined.

#### ***Claim Rejections - 35 USC § 103***

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

4. Claims 1-22, 24-26, and 27(h) are rejected under 35 U.S.C. 103(a) as being unpatentable over Applicant's admitted prior art (hereinafter APA; see specification of current application) in view of Slater (US Pat# 6,615,190, hereinafter Slater).

Art Unit: 3626

A. As per claims 1, 21, and 26, APA discloses a method for administering insurance claims and monitoring claim-related data in a database, comprising the steps of:

- (a) receiving a claim (APA: pg 2, Ins 2-3, reads on "...insured is required to submit a claim...);
- (b) investigating the claim (APA: pg 2, Ins 3-5, reads on "...evaluated by insurance company...);
- (c) determining a dollar value of the claim (APA: pg 2, Ins 6-13; pg 3, Ins 2-6);

APA fails to disclose

- (d) issuing a card account funded with the dollar value of the claim;
- (e) collecting purchase information from the card account; and
- (f) entering the purchase information into the database.

However, these features are well known in the art as evidenced by the teachings of Slater. Slater discloses

Art Unit: 3626

(d) issuing a card account funded with the dollar value of the claim

(Slater: Fig 1, items 20-24; col 3, lns 26-30; col 7, lns 25-30; Fig 1; col 4, lns 16-18);

(e) collecting purchase information from the card account; and

(f) entering the purchase information into the database (pertains to both steps e and f, Slater: col 5, lns 1-11; Fig 2, item 125; col 5, lns 21-30; Fig 2, item 130).

It would have been obvious at the time of the invention to one of ordinary skill in the art to incorporate the teachings of Slater with those of APA with the motivation of avoiding both the expense and inconvenience associated with the issuance of checks to pay insurance claims (Slater: lns 10-30).

Note: The motivation to combine the teachings of APA and Slater for claims 2-4, 6, 8, 9, 13-26, and 27(h) following in this section is the same as provided for claims 1, 21, and 26 above.

B. As per claims 2 and 3, 22(g), and 27(h), Slater discloses the method according to claim 1, further comprising the step of:

Art Unit: 3626

(g) using the database to review

(claim 2) purchase trends.

(claims 3, 22(g),

and 27(h) ) insurance investigations for accuracy (pertains to both of the above steps, Slater: col 5, Ins 1-11; Fig 2, item 125; col 5, Ins 21-30; Fig 2, item 130. The Examiner considers that once information regarding the cardholders transactions is retrieved by the card sponsor, the recited intended uses in claims 3 and 4 are available to the sponsor.).

C. As per claim 4, Slater discloses the method according to claim 1 wherein the card account is

a debit card account (Slater: col 2, Ins 19-26; col 3, Ins 26-35. The Examiner considers a card issued to an individual, associated with an account that is funded by a known amount, which limits the amount of purchases that can be made with the card by limiting the purchases to debits of the account as opposed to an extension of credit, to be a form of debit card.)

Art Unit: 3626

D. As per claim 5, APA discloses the method according to claim 1 wherein the claim is

an insurance claim (APA: pg 2, Ins 1-3).

E. As per claims 6, and 22(f), Slater discloses the method according to claim 1 wherein the purchase information reflects an actual repair cost of an automobile and further comprising the step of:

(g) comparing the determined dollar value of the claim to the actual repair cost of the automobile (Slater: col 6, ln 62 to col 7, ln 5, determined dollar value of the claim reads on "expected expenses." Note that a sponsor has access to both determined and actual costs, col 5, Ins 1-10 and 21-29, possibly provided in a list which the Examiner considers to be a form of comparison.).

F. As per claim 7, APA discloses the method according to claim 1, wherein the claim relates to

an automobile accident (APA: pg 2, Ins 1-3; pg 3, Ins 1-5).

Art Unit: 3626

G. As per claims 8 and 9, Slater discloses the method according to claim 1, wherein the claim relates to

(claim 8) medical treatment.

and

(claim 9) death benefits (pertains to both the recitations of claims 8 and 9, Slater: col 7, Ins 15-25, note that social security benefits claims include both medical treatment and death benefits.).

H. As per claim 10, APA discloses the method according to claim 1, wherein the claim relates to

property damage (APA: pg 2, Ins 1-3; pg 3, Ins 1-5. The Examiner considers an automobile accident to be a form of property damage).

I. As per claim 11, APA discloses the method according to claim 1, wherein the claim relates to

property loss (APA: pg 2, Ins 1-3; pg 3, Ins 1-5. The Examiner considers an automobile accident to be a form of property loss).



Art Unit: 3626

J. As per claim 12, APA discloses the method according to claim 1, wherein the claim relates to

theft (Slater: col 7, Ins 25-30, note that theft insurance is a common type of insurance).

K. As per claims 13-16, Slater discloses the method according to claim 1, wherein the information collected in step (e) includes

(claim 13) a time of purchase.

(claim 14) an amount of purchase.

(claim 15) a place of purchase.

(claim 16) a time, place, and amount

of each purchase (pertains to claims 13-16, Slater: Ins col 5, 3-11, note the disclosed maintenance of records for all account transactions, and the generation of a report listing the transactions. The Examiner considers such listings to include the time, place, and amount of the transactions including purchases).

Art Unit: 3626

L. As per claim 17 and 24, Slater discloses the method according to claim 1, further comprising the step of:

(g) closing the account after a predetermined amount of time (Slater: col 4, lns 37-39; Fig 1, item 36).

M. As per claim 18, Slater discloses the method of claim 17, further comprising the step of:

before step (g), reimbursing the insured any money remaining in the account (Slater: col 4, 64-66, note that the sponsor can remove funds. The Examiner considers reimbursing remaining funds from the account prior to closing the account to be a form of the sponsor removing funds. See also col 5, ln 65 to col 6, ln 15, noting that the cardholder can transfer remaining balances to another account prior to account closure.).

N. As per claim 19, Slater discloses the method of claim 1 wherein the card account is managed by an

independent claim service provider (Slater: col 3, lns 48-50, reads on "...credit network...").

Art Unit: 3626

O. As per claim 20, Slater discloses the method of claim 1 wherein the card account is managed by an

insurance company (Slater: col 2, lns 22-25; note the disclosure that a financial institution can be an issuer, that the Examiner considers an insurance company to be a type of financial institution. Note also that an insurance company can also be a sponsor, col 25-27, and further note that the sponsor is responsible for determining whether or not funds should be added to the account, which the Examiner considers to be a form of management.).

P. As per claim 25, Slater discloses the method of claim 21 wherein

the debit account has a predetermined maximum value (Slater: col 3, lns 29-31, reads on "...the funds designated by the sponsor."

5. Claims 23, 27(f), and 27(g) are rejected under 35 U.S.C. 103(a) as being unpatentable over APA in view of Slater as applied to claims 21 and 26 and above, and further in view of Rotman et al(PG Pub# US 2003/0018550, hereinafter Rotman).

Art Unit: 3626

A. As per claims 23, 27(f), and 27(g) the collective disclosure of APA and Slater fail to teach the method according to claims 21 and 26, further comprising the steps of

(claims 23(f) and 27(f) ) analyzing the collated data; and

(claims 23(g) and 27(g) ) identifying statistically significant trends in the purchase information.

However, these features are well known in the art as evidenced by the teachings of Rotman (Rotman: [0024]).

It would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate the teachings of Rotman with the collective disclosure of APA and Slater with the motivation of using purchase data to demonstrate industry-wide trends (e.g. automotive related industries) in near real-time (Rotman: [0021] – [0023]).

### ***Conclusion***

6. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The cited but not applied patent prior art discloses card-based systems for transactions associated with adjudicated insurance claims (US Pat# 6,208,973 and PG Pub# US 2005/0182660).

Art Unit: 3626


7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Martin A. Gottschalk whose telephone number is (571) 272-7030. The examiner can normally be reached on Mon - Fri 8:30 - 5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph Thomas can be reached on (571) 272-6776. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



MG  
12/07/2005

  
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SUPERVISORY PATENT EXAMINER